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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/783,980      | 02/16/2001  | Peter A. Schnall     | 5793.3014.0         | 2812             |

22852 7590 02/14/2006

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| EXAMINER |
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WEISBERGER, RICHARD C

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3624

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |   |  |  |
|------------------------------|---|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/783,980    | <b>Applicant(s)</b><br>SCHNALL, PETER A. |  |
|                              | <b>Examiner</b><br>Richard C Weisberger | <b>Art Unit</b><br>3624                  |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**TAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11, and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method is not concrete nor is it tangible. To be statutory, the method must be performed on a computer and the computer must be claimed within the body of the independent claim(s). Claims 24 is nonstatutory as it is not embedded on a computer readable medium.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims “providing loan data with information “ is confusing. What is loan data before the information is provided? Loan data appears to be the name of the file to which information is transferred. Accordingly, the limitation file should read providing a file with information. In claim 4 and elsewhere, the metes and bounds of a threshold value is unclear. Moreover, the language of claims 7 and 8 are ambiguous.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

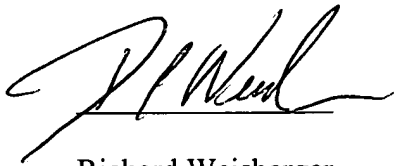
4. Claims 1-26 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Proper Conduct of Banking Business.

The document establishes the fact that guarantors are routinely notified if the unpaid indebtedness exceeds a certain threshold. (See, statement to guarantors.) The document may have been published after the effective filing date of this application. (see, 12/02 in title). If this is the publication date, then the examiner takes official notice the similar banking codes of conduct have existed prior to the effective filing date of this application. The prior art fails to expressly teach an apparatus comprising a processor and memory comprising instructions to automate the above process. The reference is silent as to the degree to which this notification has been automated. The examiner takes official notice that banks routinely automate the process of monitoring loans and it seems reasonable to believe that the automation of the notification of the guarantor would also be inherent in the process. A rejection under 35 U.S.C. 102/103 can be made when the prior art product seems identical to that of the prior art except that it is silent to a inherent characteristic. “There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102.” In re Best, 562 F.2d 1252, 1255

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n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). In the alternative it would have been obvious for one skilled in the art at the time to have automated the notification of the guarantor as motivated by the need to reduce errors in the notification process. As to the nature of the information sent to the guarantor, e.g., claims 7-8, the choice of descriptive information sent to the guarantor is a set of art recognized variables. The use of these art recognized variables for their art recognized result is per se obvious.

Respectfully,

A handwritten signature in black ink, appearing to read 'R. Weisberger', written over a horizontal line.

Richard Weisberger

Primary Examiner AU 3624

571 272 6753